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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Geoffrey D. Alexander

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EXAMINER

HAQ, NAEEM U

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,342

Applicant(s)

ALEXANDER, GEOFFREY D.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 9, 2005 has been entered. Claims 1-37 are pending and will be considered for examination.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 6, 7, 14, 19, 20, 27, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US 5,960,411) hereafter referred to Hartman in view of Bezos et al. (6,029,141) hereafter referred to as Bezos.

Referring to claim 1: Hartman teaches a method, system and computer program for providing online comparison shopping by a website system accessible by a user through a communication network, the method comprising the steps of: compiling a shopping list identifying specific items to be purchased (Figure 1C, items '106' and '107'); receiving optimization criteria specified by the user (Figure 1A, items "103c" and

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"103d"; Figure 1C, item "108"); optimizing, by the website system, the shopping list based on the optimization criteria to produce an optimal shopping order (column 5, lines 27-55, lines 50-55; col. 8, lines 1-67); displaying the optimal shopping order to the user (Figure 1C, items "106" and "107"; col. 5, lines 40-43). Hartman does not teach optimization of items from two or more of the vendors. However, Bezos discloses an online shopping method, program and system that has a shopping cart data structure allowing customers to select and store items from two or more merchants and perform a single check-out to purchase all of the selected products (col. 2, line 66 – col. 3, line 2; col. 13, lines 9-28). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the shopping cart of Bezos into the invention of Hartman. One of ordinary skill in the art would have been motivated to do so in order to allow a user to purchase items from multiple vendors from a single website during a single session, as taught by Bezos. Hartman does not explicitly teach comparison shopping. However, the Examiner notes that this limitation appears in the preamble only. Furthermore, the body of the claim does not depend on this limitation for completeness. *"A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone."* See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Thus this limitation does not patentably distinguish the

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claimed invention from the prior art because the body of the claim does not depend on this limitation for completeness.

Referring to claim 6: Hartman and Bezos teach or render obvious all the limitations of claim 1 as noted above. Furthermore, Hartman discloses that the optimization criteria includes a user-preferred shipping method (Figure 1C, item "108"; Figure 1A, items "103c" and "103d").

Referring to claim 7: Hartman and Bezos teach or render obvious all the limitations of claim 1 as noted above. Furthermore, Hartman discloses providing by the website system a website accessible by the user for receiving inputs from the user to perform the displaying step (col. 3, line 64 – col. 4, line 3; Figure 1C, items "106" and "107"; col. 5, lines 40-43).

Referring to claims 14 and 27: Claims 14 and 27 are rejected under the same rationale as set forth above in claim 1.

Referring to claims 19 and 32: Claims 19 and 32 are rejected under the same rationale as set forth above in claim 6.

Referring to claims 20 and 33: Claims 20 and 33 are rejected under the same rationale as set forth above in claim 7.

Referring to claim 34: Hartman and Bezos teach or render obvious all the limitations of claim 27 as noted above. Furthermore, Hartman discloses storage, accessible by a processor, for storing information (col. 5, lines 17-26). Hartman does not expressly disclose that the information stored is vendor's shipping method information and product information. However, the Examiner notes that this limitation is

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not functionally or structurally involved in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The elements of the system would be the same regardless of what information was stored by the system. The differences between the content of the Applicant's data and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any data in the system of Hartman because such data does not functionally or structurally relate to the elements of the claimed system and because the subjective interpretation of such data does not patentably distinguish the claimed invention.

Claims 2, 3, 4, 5, 10-13, 15-18, 23-26, 28-31, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US 5,960,411) hereafter referred to Hartman in view of Bezos et al. (6,029,141) hereafter referred to as Bezos and further in view of Official Notice.

Referring to claims 2, 4, 5, 13, 15, 17, 18, 26, 28, 30, 31, and 37, Hartman teaches the limitations of claims 1, 6, 7, 14, 19, 20, 27, 32, and 33 as noted above. Hartman does not teach receiving the user's modifications to the optimal shopping order; re-optimizing the shopping list based on the modifications to produce an updated optimal shopping order; and displaying the updated optimal shopping order to the user. However, Official Notice is taken that it is old and well known in the art to receive the

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user's modifications to the optimal shopping order; re-optimizing the shopping list based on the modifications to produce an updated optimal shopping order; and displaying the updated optimal shopping order to the user. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the method, system and program of Hartman. One of ordinary skill in the art would have been motivated to do so in order to allow a user to develop various "what if" scenarios from which to choose the most favorable.

Referring to claims 3, 16, and 29, Hartman teaches the limitations of claims 1, 14 and 27 as noted above. Hartman does not teach receiving an acceptance of the optimal shopping order from the user; and processing the optimal shopping order in response to the receipt of the acceptance from the user. However, Official Notice is taken that it is old and well known in the art to process an order based on receiving an acceptance of the optimal shopping order from the user; and processing the optimal shopping order in response to the receipt of the acceptance from the user. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature in the invention of Hartman. One of ordinary skill in the art would have been motivated to do so in order to be more responsive to a customer.

Referring to claims 10 and 23, Hartman teaches the limitations of claims 1 and 14 as noted above. Hartman does not teach that the optimizing step is performed off-line; or notifying the user with a notification message when the off-line optimizing step is completed. However, Official Notice is taken that it is old and well known in the art to

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perform processing off-line and to provide a notification message when the processing is completed. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the invention of Hartman. One of ordinary skill in the art would have been motivated to do so in order to avoid excessive on-line charges.

Referring to claims 11 and 24, Hartman teaches the limitations of claims 1 and 14 as noted above. Hartman does not teach that the notification message is communicated to the user using e-mail. However, Official Notice is taken that it is old and well known in the art to use email notification messages. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate email notifications into the invention of Hartman. One of ordinary skill in the art would have been motivated to do so in order to use a well-known and widely available communication tool for sending notifications.

Referring to claims 12 and 25, Hartman teaches the limitations of claims 1 and 14 as noted above. Hartman does not teach that the notification message includes a unique identifier to be used by the user to access the optimal shopping order through the website system. However, the use of a URL as a unique identifier that is used by a user to access a shopping order through a website system is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate an embedded URL link in a notification message in the invention of Hartman. One of ordinary skill in the art would have been motivated

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to do so in order to allow a user to access information by clicking on a link rather than by typing a long URL.

Referring to claims 35 and 36, Hartman teaches the limitations of claim 27 as noted above. Hartman does not teach notifying the user when its shopping order optimization process fails, or repeating shopping order optimization process until an optimal shopping order is produced, and notifying the user when the optimization process produces the optimal shopping order. However, Official Notice is taken that it is old and well known in the art for a program to provide error recovery in the event the program fails to process data properly. The error recovery typically notifies a user when a process fails, repeats the process, and notifies the user when the processing is successful. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the invention of Hartman. One of ordinary skill in the art would have been motivated to do so in order to provide a user-friendly way of handling processing failure.

Response to Arguments

Applicant's arguments with respect to claims 1, 6, 7, 14, 19, 20, 27, 32-34 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to the rejection of claims 2-5, 10-13, 15-18, 23-26, 28-31, and 35-37 under 35 U.S.C. §103 have been fully considered but they are not persuasive. In order to adequately traverse a rejection based on common knowledge (i.e. Official Notice), an Applicant must specifically point out the supposed

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errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the Examiner's assertion of Official Notice is inadequate. In the present case, the Applicant as not argued why the noticed fact is not considered to be common knowledge or well-known in the art. Instead, the Applicant has provided a general allegation of patentability of the rejected claims. For this reason, Applicant's response is considered to be an inadequate traversal of the Official Notice used in the rejection of claims 2-5, 10-13, 15-18, 23-26, 28-31, and 35-37 under 35 U.S.C. §103.

Since the Applicants have failed to seasonably challenge the Examiner's Official Notice presented in the previous Office Actions, the Examiner now interprets all Official Notices as admitted prior art. *Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made. In re Selmi, 156 F.2d 96, 70 USPQ 197 (CCPA 1946). If Applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d71, 60 USPQ 239 (CCPA 1943). Also see MPEP 2144.03.*

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571)-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Naeem Haq', with a stylized, flowing script.

Naeem Haq, Patent Examiner
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September 6, 2005